

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

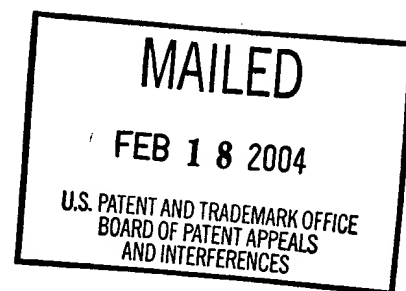
Ex parte HEINZ BOSS

Application No. 09/426,023

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on January 23, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

In the Examiner's Answer mailed May 15, 2003 (Paper No. 21), the Examiner set forth the following grounds of rejection: Claims



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Claims 1-10 were rejected under 35 U.S.C. § 102(b) as anticipated U.S. Patent No. 5,114,128. The Examiner then incorporates by reference the rejections as set forth in the Final Rejection mailed November 2, 2001 (Paper No. 7). However, it is noted that the Final Rejection includes a rejection for Claim 4 under 35 U.S.C. § 103(a), as being obvious over U.S. Patent No. 5,114,128. The rejection of claim 4 in the Final Rejection mailed November 2, 2001, is not addressed in the Examiner's Answer. The above mentioned discrepancies causes confusion as to which claims are rejected. Appropriate correction is required.

A further review of the Examiner's Answer was mailed (Paper No. 21) reveals that the examiner did not address the "Arguments" presented in appellant's Appeal Brief dated March 4, 2003. The Examiner is required by MPEP 1208 (8th ed rev. 1 Feb 2003) on page 1200-19 to:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.

(11) Response To Argument. A Statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. If any ground of rejection is not argued and replied to by appellant, the response shall point out each claim affected.

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A continued review of the Examiner's Answer mailed May 15, 2003 (Paper No. 21), reveals that prior art identified in the Examiner's Answer is not limited to the prior art cited to sustain the rejection of Claims 1-10 in the Final Rejection dated November 2, 2001. See Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., rev. 1, Feb. 2003).

According to MPEP § 1208:

(9) References of Records. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

Lastly, a review of the Examiner's Answer mailed May 15, 2003 (Paper No. 21), reveals that information contained therein pertaining to the required appeals conference is not in compliance with the Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., rev. 1, Feb. 2003).

According to MPEP § 1208:

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the type or printed names of the other two appeal conference participants. These two appeal conference

participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

The Examiner's Answer was not initialed or signed by the conferee's as required under MPEP § 1208.

Accordingly, it is

ORDERED that the application is returned to the examiner for:

- 1) vacate the Examiner's Answer dated May 15, 2003 (Paper No. 21);
- 2) issue a new Examiner's Answer setting forth all pertinent rejections;
- 3) the new Examiner's Answer must respond to the Appellant's arguments from the Appeal Brief (Paper No. 21);
- 4) the new Examiner's Answer should also limit the references cited to the prior cited used to maintain the Final Rejection of claims 1-10 (Final Rejection, mailed November 2, 2001);
- 5) correction of the Examiner's Answer to acknowledge the Appeals Conference by identifying the names, initials and/or signatures of all conferee's;
- 6) that this application be retained in Technology Center 3600 for two months after mailing of the new Examiner's

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Answer as to permit appellants to respond to the new
Examiner's Answer; and
7) for such further action as may be appropriate.

It is important that the Board of Patent Appeals and
Interferences be informed promptly of any action affecting the
status of the appeal (i.e., abandonment, issue, reopening
prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

A handwritten signature in dark ink, appearing to read 'Dale M. Shaw', is written over a horizontal line.

DALE M. SHAW
Program and Resource Administrator
(703) 308-9797

DMS/dpv
RA04-0232

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FRIEDRICH KUEFFNER
342 MADISON AVE.
SUITE 1921
NEW YORK, NY 10173